

Procter & Gamble - I.P. Division

DEC 20 2004

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**FACSIMILE TRANSMITTAL SHEET AND
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Cheryl L. Martini (Signature)

FROM: Eric T. Addington

Fax No. 513-634-3004

Phone No. 513-634-1602

Listed below are the item(s) being submitted with this Certificate of Transmission:**

- 1) Fee Transmittal
- 2) Appeal Brief (15 pages)

Inventor(s): Olaf Isele et al.

S.N.: 09/895,027

Filed: June 29, 2001

Docket No.: 8610

Number of Pages Including this Page: 17

Comments:

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DEC 20 2004 513 634 3499 P.02/17
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL for FY 2005 Patent fees are subject to annual revision. Effective December 8, 2004	Complete if Known	
	Application Number	09/895,027
	Confirmation Number	7458
	Filing Date	June 29, 2001
	First Named Inventor	Olaf Isele
	Examiner Name	L.S. Channavajjala
	Art Unit	1615
TOTAL AMOUNT OF PAYMENT (\$) 500		Attorney Docket No. 8610

METHOD OF PAYMENT		FEE CALCULATION (continued)																																														
1. [X] The Director is hereby authorized to charge indicated fees submitted on this form, credit any over payments, and charge any additional fee(s) during the pendency of this application to: Deposit Account Number: 16-2480 Deposit Account Name: The Procter & Gamble Company		5. ADDITIONAL FEES <table border="1"> <thead> <tr> <th>Fee Description</th> <th></th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr> <td>Extension for reply within 1st month</td> <td>(\$120)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 2nd month</td> <td>(\$450)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 3rd month</td> <td>(\$1,120)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 4th month</td> <td>(\$1,590)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 5th month</td> <td>(\$2,160)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Information Disclosure Statement fee</td> <td>(\$180)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>37 CFR 1.16(e) Late Oath/Declaration (nonprovisional)</td> <td>(\$130)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>37 CFR 1.17 (q) Missing Parts (provisional)</td> <td>(\$50)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Non-English specification</td> <td>(\$130)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Notice of Appeal</td> <td>(\$500)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Filing a brief in support of an appeal</td> <td>(\$500)</td> <td>500</td> </tr> <tr> <td>Request for oral hearing</td> <td>(\$1,000)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Acceptance of unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (a) or (c)</td> <td>(\$1,370)</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Other:</td> <td></td> <td><input type="checkbox"/></td> </tr> </tbody> </table>		Fee Description		Fee Paid	Extension for reply within 1 st month	(\$120)	<input type="checkbox"/>	Extension for reply within 2 nd month	(\$450)	<input type="checkbox"/>	Extension for reply within 3 rd month	(\$1,120)	<input type="checkbox"/>	Extension for reply within 4 th month	(\$1,590)	<input type="checkbox"/>	Extension for reply within 5 th month	(\$2,160)	<input type="checkbox"/>	Information Disclosure Statement fee	(\$180)	<input type="checkbox"/>	37 CFR 1.16(e) Late Oath/Declaration (nonprovisional)	(\$130)	<input type="checkbox"/>	37 CFR 1.17 (q) Missing Parts (provisional)	(\$50)	<input type="checkbox"/>	Non-English specification	(\$130)	<input type="checkbox"/>	Notice of Appeal	(\$500)	<input type="checkbox"/>	Filing a brief in support of an appeal	(\$500)	500	Request for oral hearing	(\$1,000)	<input type="checkbox"/>	Acceptance of unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (a) or (c)	(\$1,370)	<input type="checkbox"/>	Other:		<input type="checkbox"/>
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FEE CALCULATION 2. BASIC FILING FEE - Large Entity <table border="1"> <thead> <tr> <th></th> <th>FILING FEE</th> <th>SEARCH FEE</th> <th>EXAMINATION FEE</th> <th></th> </tr> </thead> <tbody> <tr> <td>Application Type</td> <td></td> <td></td> <td></td> <td>Fee Paid</td> </tr> <tr> <td>Utility</td> <td>(\$300)</td> <td>(\$500)</td> <td>(\$200)</td> <td>(Total = \$1000) <input type="checkbox"/></td> </tr> <tr> <td>Design</td> <td>(\$200)</td> <td>(\$100)</td> <td>(\$130)</td> <td>(Total = \$430) <input type="checkbox"/></td> </tr> <tr> <td>Reissue</td> <td>(\$300)</td> <td>(\$500)</td> <td>(\$600)</td> <td>(Total = \$1400) <input type="checkbox"/></td> </tr> <tr> <td>Provisional filing fee</td> <td></td> <td></td> <td></td> <td>(Total = \$200) <input type="checkbox"/></td> </tr> </tbody> </table>			FILING FEE	SEARCH FEE	EXAMINATION FEE		Application Type				Fee Paid	Utility	(\$300)	(\$500)	(\$200)	(Total = \$1000) <input type="checkbox"/>	Design	(\$200)	(\$100)	(\$130)	(Total = \$430) <input type="checkbox"/>	Reissue	(\$300)	(\$500)	(\$600)	(Total = \$1400) <input type="checkbox"/>	Provisional filing fee				(Total = \$200) <input type="checkbox"/>	SUBTOTAL (2)+(3) (\$)																
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3. APPLICATION SIZE FEE: Sheets of Spec and Drawings <input type="checkbox"/> (\$250 for each 50 sheets in excess of 100, except for sequence and program listings)		SUBTOTAL (4) (\$)																																														
4. EXTRA CLAIM FEES FOR UTILITY AND REISSUE: <table border="1"> <thead> <tr> <th></th> <th>Extra Claims</th> <th>Fee from Below</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr> <td>Total Claims 20 - 20** = <input type="checkbox"/> x</td> <td><input type="checkbox"/></td> <td>=</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Independent Claims <input type="checkbox"/> - 3** = <input type="checkbox"/> x</td> <td><input type="checkbox"/></td> <td>=</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Multiple Dependent claims:</td> <td><input type="checkbox"/></td> <td>=</td> <td><input type="checkbox"/></td> </tr> </tbody> </table> ** or number previously paid, if greater; For Reissues, see below Fee Description Claims in excess of 20 (\$50 per claim) Independent claims in excess of 3 (\$200 per claim) Multiple dependent claim, if not paid (\$360) **Reissue: each independent claim over 3 and more than in the original patent (\$200 per claim) **Reissue claims: each claim over 20 and more than original patent (\$50 per claim)			Extra Claims	Fee from Below	Fee Paid	Total Claims 20 - 20** = <input type="checkbox"/> x	<input type="checkbox"/>	=	<input type="checkbox"/>	Independent Claims <input type="checkbox"/> - 3** = <input type="checkbox"/> x	<input type="checkbox"/>	=	<input type="checkbox"/>	Multiple Dependent claims:	<input type="checkbox"/>	=	<input type="checkbox"/>	SUBTOTAL (5) (\$) 500.00																														
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SUBMITTED BY		Complete (if applicable)	
Name (Print/Type)	Eric T. Addington	Registration No.	52,403
Signature		Telephone	(513) 634-1602
		Date	12/20/04

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon individual case. Any comments on the amount of time you are required to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P. O. Box 1430, Alexandria, VA 22313-1430. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Cheryl L. Martin	N/A
Name	Registration No. (if applicable)
<i>Cheryl L. Martin</i>	
Signature	
December 20, 2004	Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	09/895,027
Applicant(s)	:	Olaf Isele, et al.
Filed	:	June 29, 2001
Title	:	Top-Biased Beneficial Components on Substrates
TC/A.U.	:	1615
Examiner	:	L.S. Channavajjala
Conf. No.	:	7458
Docket No.	:	8610
Customer No.	:	27752

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir,

This Brief is filed pursuant to the appeal from the U.S. Patent and Trademark Office decision of Paper No. 07152004 dated July 20, 2004. A timely Notice of Appeal was filed on October 20, 2004.

REAL PARTY IN INTEREST

The real party of interest is The Procter & Gamble Company of Cincinnati, Ohio.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals, interferences, or judicial proceedings.

STATUS OF CLAIMS

Claims 1-3 and 5-21 stand rejected. Claim 4 was cancelled without prejudice.

Claims 1-3 and 5-21 are appealed.

A complete copy of the appealed claims is set forth in the Claims Appendix attached herein.

STATUS OF AMENDMENTS

An after final reply was submitted on September 20, 2004; however, no amendments to the claims were presented.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 relates to an article of manufacture for use in contact with a target surface (page 2, lines 20-22). The article of manufacture comprises a liquid permeable porous substrate having a contacting surface (page 3, lines 25-33; Fig. 2 item 91) and an opposing surface (page 2, lines 24-31; Fig. 2 item 95) disposed oppositely thereto. The liquid permeable porous substrate has a thickness of "Z" as measured from the contacting surface to the opposing surface (page 3, lines 14-18). The article of manufacture comprises a beneficial component (page 8, lines 4-14; Fig. 2 item 96) releasably disposed on at least a portion of the contacting surface (page 3, lines 36-37; page 8, lines 4-14). The beneficial component comprises at least a first layer and a second layer (page 16, lines 21-23), whereby the ratio of the quantity of the beneficial component present on or within the thickness between 0 and $Z/3$ of the substrate is at least about 2.2 times the quantity of the component within the thickness between $2Z/3$ and Z of the substrate until the time of the use of the article (page 3, lines 11-18).

Claim 9 relates to an article comprising a contacting surface (page 3, lines 25-33; Fig. 2 item 91) having a beneficial component (page 8, lines 4-14; Fig. 2 item 96) disposed on at least a portion thereof (page 2, lines 24-27). The beneficial composition comprises a first layer and a second layer (page 16, lines 21-23). The first layer is disposed on the contacting surface (page 17, lines 1-2); the second layer is disposed on the first layer (page 17, lines 3-4); and the first layer makes up between about 5% and about 95% of the beneficial component (page 17, lines 17-19).

Claim 16 relates to method for top-biasing a composition on a porous substrate. The method comprises a step of applying a first layer of a relatively hydrophilic component on the porous substrate (page 18, lines 4-6; page 20, lines 11-15). The method comprises a step of applying a second layer of a relatively hydrophobic component on the relatively hydrophilic component (page 18, lines 4-6; page 20, lines 11-15). The method comprises a step of allowing the first layer and second layer to simultaneously cool on the substrate without the formation of an emulsion (page 20, lines 11-15).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-3 and 5-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over International Publication No. WO 00/64502 to Krzysik et al. (hereafter "Krzysik").

ARGUMENTS

Claims 1-3 and 5-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over International Publication No. WO 00/64502 to Krzysik.

The Office's reasoning for this rejection is provided in the Office Action dated July 20, 2004 (Paper 07152004). In support of this rejection, the Office states:

WO teaches an absorbent article having a liquid impermeable outer surface, a middle absorbent portion and a top liquid permeable bodyside liner facing the wearer (see figure 2 of WO). WO teaches that the bodyside liner may be made of woven or nonwoven materials, less hydrophilic to be dry, porous (page 12, lines 15-32). The bodyside liner includes a lotion formulation on the outer bodyfacing surface and is (sic) comprises wax, emollient and a viscosity enhancer, that acts as a lubricant to reduce the abrasion of skin caused by liner and also transfers to the skin to provide improved skin health (abstract, page 13, lines 15-22) including fatty alcohols, lanolin or lanolin derivatives, petroleum based oils (page 13, lines 22-35), waxes for immobilizing the emollient and reduce its tendency to migrate (page 14), viscosity enhancers such as talc, silica, cellulose and modified cellulose derivatives and other skin treating compounds such as glycerin, zinc oxide, etc (page 15 and 16).

Office Action of July 20, 2004. The Office concedes that Krzysik "does not teach the claimed thickness of the beneficial components on the porous substrate (sic) i.e., 2.2 times more in the top third portion of the porous substrate than the bottom 2/3 portions." The Office goes on to state:

[Krzysik] teaches the lotion can be applied to the bodyside liner at 0.05-100 mg/cm². Accordingly, it would have been within the scope of a skilled artisan to optimize the amounts of lotion applied on the absorbent applied on the article (sic). The expected result would be a minimum migration of the solidified components applied to the bodyside line (sic).

Office Action of July 20, 2004. Furthermore, the Office argues that Krzysik "states that a z-direction migration loss test shows that the migration of the lotion on the absorbent article is very low."

Appellant does not dispute that Krzysik discloses an absorbent article having a bodyside liner including a lotion formulation on the outer bodyfacing surface. Krzysik discloses a lotion formulation comprising from about 5 to about 95 weight percent of an emollient, from about 5 to about 95 weight percent of a wax, and, optionally, from about 0.1 to about 25 weight percent of a viscosity enhancer. Krzysik states that the lotion formulation has a reduced level of migration which leads to improved transfer to the skin. *Abstract.*

Appellant respectfully submits that the Office has failed to make a *prima facie* case for the obviousness rejection.

A. Claim 1

1. The Office fails to ascertain the differences between the prior art and the claims at issue. As part of the initial obviousness determination, the "differences between the prior art and the claims at issue are to be ascertained." *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). The Office could not have properly ascertained the differences between Appellant's claims and Krzysik since the Office mischaracterizes the limitation present in Appellant's Claim 1. The Office states that Krzysik "does not teach the claimed thickness of the beneficial components on the porous substrate." Appellant makes no mention of the "thickness of the beneficial components" in Claim 1. Appellant's limitation is directed to "a beneficial component releasably disposed on at least a portion of the contacting surface; wherein the beneficial component comprises at least a first layer and a second layer, whereby the ratio of the quantity of the beneficial component present on or within the thickness between 0 and $Z/3$ of the substrate is at least about 2.2 times the quantity of the component within the thickness between $2Z/3$ and Z of the substrate until the time of the use of the article." Since the Office has mischaracterized the present claim, Appellant asserts that the Office could not have properly ascertained the differences between Krzysik and the present claim. As a result, the Office has failed in its establishment of a *prima facie* case of obviousness.

2. The Office has failed to present factual support or a convincing line of reasoning in support of a reasonable expectation of success for the Office's proposed modification. The Office argues that since Krzysik teaches that the lotion can be applied at 0.05-100 mg/cm², "it would have been within the scope of a skilled artisan to optimize the amounts of lotion applied on the absorbent article" and that "[t]he expected result would be a minimum migration of the solidified components applied to the bodyside liner." *Office Action of July 20, 2004*. Case law clearly places the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967). The Office asserts that optimizing the amount of lotion applied on an absorbent article will produce the expected result of minimum migration of the solidified components to the bodyside liner. The Office provides no factual basis for this "expected result." This assertion posited by the Office is based on mere subjective expectation that is neither convincing nor supported in fact.

3. The reference relied upon by the Office fails to teach Appellant's "ratio of the quantity of the beneficial component" limitation as recited in Claim 1. Krzysik does not teach or suggest Appellant's claim limitation of a "ratio of the quantity of the beneficial component present on or within the thickness between 0 and $Z/3$ of the substrate is at least about 2.2 times the quantity of the component within the thickness between $2Z/3$ and Z of the substrate until the time of the use

of the article." The Office states that since Krzysik teaches a migration loss that is "more desirably no more than 35% . . . it is clear that both the instant invention and WO desire the same result." Desiring the same result is immaterial; the inquiry is on whether Krzysik teaches or suggests each and every limitation of Appellant's Claim 1. The Office has failed to point to a passage within Krzysik that discloses Appellant's limitation of a "ratio of the quantity of the beneficial component present on or within the thickness between 0 and $Z/3$ of the substrate is at least about 2.2 times the quantity of the component within the thickness between $2Z/3$ and Z of the substrate until the time of the use of the article." Therefore, even if "the instant invention and WO desire the same result," Krzysik does not teach Appellant's claimed ratio that has been found necessary to achieve the desired result.

Furthermore, Krzysik does not suggest Appellant's claimed ratio of beneficial component. The Office appears to rely on the Z-Direction Migration Test of Krzysik to suggest the Appellant's claimed ratio of beneficial component; however, such reliance on the Krzysik test is erroneous. The Office equates the Krzysik Z-Direction Lotion Migration Test and results (Krzysik, page 21-22) as equivalent to Appellant's method for determining the top-bias ratio (see page 21, lines 12 to page 23, line 13). The Krzysik test and Appellant's tests are distinct and measure differing properties of the substrate bearing the beneficial component. Case law states, "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir 1986) citing *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA 1965).

The Z-Direction Lotion Migration Test is "a measure of the lotion migration after [article] storage at 130°F when compared to the lotion migration at 73°F after a fixed period of time." See Krzysik, page 21, lines 11-13. The test involves subjecting a sample of the bodyside liner to Soxhlet Extraction whereby "chloroform dissolves the lotion from the liner sample." Krzysik makes no mention of extracting lotion from particular layers or regions of the bodyside liner. Appellant asserts that the chloroform in the Z-Direction Lotion Migration Test dissolves the lotion regardless of its location in or on the liner sample, whether on the bodyfacing side of the liner, on the opposite side of the liner, or within the liner. The resulting measurement is of the total amount of lotion present on and within the sample at the time of measurement. Since Krzysik cannot determine the concentration of lotion in or on the liner, it is clear that the Krzysik test will not be able to determine lotion concentration present in thicknesses of the sample between $0 - 1/3Z$, $1/3Z - 2/3Z$, or $2/3Z - Z$, when Z is the measured thickness of the sample. The

Office has failed to appreciate this difference between the tests of Krzysik's disclosure and Appellant's claimed invention.

The Office's reliance on the Krzysik Z-Direction Lotion Migration Test is further misplaced because while the title of the test is "Z-Direction Lotion Migration Test," it is clear that lotion may migrate in other directions. Krzysik states that the test predicts, in part, "how quickly [the lotion] will undesirably migrate away from or along the body facing surface of the article in use." *Krzysik*, page 21, lines 13-16. Movement away from or along the body facing surface indicates that lotion is migrating in directions other than or in addition to through the thickness (z-direction) of the liner in Krzysik. As a result, it appears that the Office has relied on the Krzysik Z-Direction Lotion Migration Test to suggest Appellant's ratio of the quantity of the beneficial component without appreciating what the Krzysik test truly measures.

In summary, the Office has failed to show how Krzysik teaches or suggests Appellant's claim limitation of a "ratio of the quantity of the beneficial component present on or within the thickness between 0 and Z/3 of the substrate is at least about 2.2 times the quantity of the component within the thickness between 2Z/3 and Z of the substrate until the time of the use of the article for the following reasons: (i) there is no mention in Krzysik of a ratio of beneficial component in various layers of a substrate, (ii) the Krzysik test cannot determine lotion concentration on or within discrete thicknesses of the liner, and (iii) the Krzysik test measures migratory loss of the lotion in directions other than the Z-direction. As a result of these findings, the Office has failed to meet its burden of providing a factual basis for the rejection; the Office has assumed more than what Krzysik test teaches.

4. The reference relied upon by the Office fails to teach Appellant's limitation of "the beneficial component comprises at least a first layer and second layer" as recited in Claim 1. The Office makes the following assumptions:

[I]nstant claim 1 only states first and second layer, but does not require that the two layers be different. Therefore, if the (sic) both layers are to contain the same beneficial component, the process of layering the beneficial component only results in mixing up the components and the layers do not remain distinct.

[I]nstant specification states (page 16) that the hydrophilicity and hydrophobicity of the first and second layers is not critical.

[A]pplicants have not shown any unexpected results with the beneficial component being in the form of layers as opposed to being applied as a single composition.

See Office Action dated June 20, 2004, page 5. Based upon these assumptions, the Office concludes that "incorporating the beneficial component on the article as a single (layer) component or as different layers by routine optimization would be within the gambit of a skilled

artisan." Both the Office's assumptions and conclusion of "routine optimization" are unsupported and/or are without merit.

Initially, Appellant wishes to point out that the Office has not pointed to any passage within Krzysik that teaches or suggests two layers of beneficial component. The Office's support for the assertion (i.e., "incorporating the beneficial component on the article as a single (layer) component or as different layers by routine optimization would be within the gambit of a skilled artisan") appears to be based solely upon reference to Appellant's disclosure. Case law has held that the teaching or suggestion to modify the prior art must be found in the prior art and not in Appellant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Such reference to Appellant's disclosure in support of an obviousness rejection suggests impermissible hindsight.

Appellant asserts that the Office's conclusion that incorporating the beneficial component as layers would be within the gambit of a skilled artisan" is unsupported and does not follow from the assumptions made by the Office.

The first assumption suggests a process and is not directed to the claim as written. Appellant fails to see how the Office's assumption (i.e., "the process of layering the beneficial components only results in mixing up the components") teaches Appellant's limitation of an article comprising, in part, a beneficial component comprising a first layer and a second layer. The Office's assumption is directed to a process which does not address the limitation of an article, and the Office's assumed result achieved from this hypothetical layering process is immaterial. The Office still has not pointed to something in the prior art that teaches or suggests Appellant's recited limitation. The Office appears to be attacking the language of Appellant's claim as opposed to finding a prior art reference that teaches or suggests Appellant's limitation. Furthermore, even if the Office is correct about "layering the beneficial components only results in mixing up the components," the Office has failed to provide any reasoning on how or why Krzysik should be modified to result in Appellant's claimed invention. Instead, the Office's assumption is absent factual support or a convincing line of reasoning regarding the motivation for applying a first and second layer.

The second assumption suggests that the relative hydrophilicity or hydrophobicity of the layers is not critical. The Office states that the "instant specification states (page 16) that the hydrophilicity and hydrophobicity of the first and second layers is not critical." Claim 1 does not refer to hydrophilicity or hydrophobicity of the layers. As such, discussion of hydrophilic or hydrophobic layers appears irrelevant. Even if it relevant, the Office is using the Appellant's disclosure in support of the obviousness rejection. The basis for the obviousness rejection must be found in the prior art. Further discussion of the hydrophilicity or hydrophobicity of the layers is presented in reference to Claim 5.

The third assumption relates to the unexpected results achieved by the layers. The Office states that "applicants have not shown any unexpected results with the beneficial component being in the form of layers as opposed to being applied as a single composition." To the contrary, the Office was directed to page 21, line 23 to page 23, line 13 of the specification. Three conditions are provided in the chart on page 23 along with the resulting top-bias ratio. Condition "i" represents a single layer of just lotion. Condition "ii" represents two layers, water/glycerin and lotion. Condition "iii" represents three layers; water/glycerin, lotion, and water. The top-bias ratios for conditions i, ii, and iii are 2.1:1, 2.9:1, and 3.7:1, respectively. These results show the unexpected result of an increased top-bias ratio where a beneficial component comprises a first and second layer (i.e., conditions ii and iii) as opposed to a single layer (i.e., condition i). The Office's assertion that "applicants have not shown any unexpected results" is inaccurate given that ample support exists within the present specification showing the results.

B. Claim 5

1. The Office mischaracterizes Appellant's disclosure regarding relative hydrophilicity and hydrophobicity of the layers. Claim 5, dependent upon Claim 1, recites "at least one layer is relatively hydrophilic and at least one layer is relatively hydrophobic." The Office states that "applicants themselves state that the relative hydrophilicity or relative hydrophobicity is not critical. Accordingly, if the two layers have [sic] same hydrophobicity or hydrophilicity to each other, the resulting beneficial component applied on the substrate would be the same as that of the WO." The Office has selectively read and overstated Appellant's disclosure and disregarded the plain meaning of Claim 5. Appellant, on page 16, lines 24-32 recites various embodiments of the present invention. One embodiment teaches the two layers as differing in hydrophilicity or hydrophobicity. In another embodiment, the relative hydrophilicity or relative hydrophobicity is not critical. Another embodiment speaks to a layer being a volatile base layer. Appellant has merely stated that in some embodiments the relative hydrophilicity or relative hydrophobicity of the layers are not critical; however, in other embodiments, the relative hydrophilicity or relative hydrophobicity may be important. The Office's sweeping statement that the "instant specification states (page 16) that the hydrophilicity and hydrophobicity of the first and second layers is not critical" is overly broad and misleading. Claim 5 is clearly directed to an embodiment where one layer is relatively hydrophilic and one layer is relatively hydrophobic. The Office appears to be using Appellant's disclosure as the basis for the rejection rather than pointing to some teaching in Krzysik that teaches or suggests the limitations of Claim 5.

2. The reference relied upon by the Office teaches away from Appellant's claim limitation of relatively hydrophilic and relatively hydrophobic layers. Krzysik teaches that its

lotion formulation is prepared by "mixing until all ingredients were melted and uniform." *Krzysik*, page 25, lines 21-26. *Krzysik*'s teaching of uniformity of the ingredients, both hydrophilic and hydrophobic ingredients, is contrary to Appellant's claimed layers. If *Krzysik*' composition is uniform (i.e., both hydrophilic and hydrophobic ingredients are mixed together), the Office cannot read *Krzysik* as teaching a hydrophilic layer and a hydrophobic layer. As such, the Office has failed to consider *Krzysik* as a whole and appreciate the clear teaching away from Appellant's claimed invention that exists therein.

3. The Office has presented no motivation to modify the article of *Krzysik* so as to yield Appellant's claimed invention. While *Krzysik* may teach hydrophilic and hydrophobic ingredients for the lotion formulation, Appellant claims relatively hydrophilic and relatively hydrophobic layers. *Krzysik* does disclose that its lotion formulation may be applied as stripes. *Krzysik*, page 19, line 32. However, Appellant fails to see the factual support for the Office's conclusion that *Krzysik*'s lotion deposition pattern of stripes suggests that the lotion may be applied in layers, wherein one layer is relatively hydrophobic and one layer is relatively hydrophilic. The Office has failed in its initial burden to factually support the *prima facie* case of obviousness.

C. Claim 9 and 16

With regard to Claims 9 and 16, the Office concedes two points in that *Krzysik* "does not explicitly teach layers of beneficial component or disposing a first hydrophilic layer followed by a hydrophobic layer." However, the Office states that *Krzysik* teaches or suggests the following four points:

[L]imiting the lotion to restricted areas of the article such that migration to the interior or lateral migration of (sic) the absorbent body is not observed.

[A]pplying the lotions to discreet (sic) areas as stripes as (sic) full length or a portion of the article and further in an add-on level, including the claimed steps of applying the component and solidifying.

[D]eposition of wax, emollients, and other viscosity enhancers such as celluloses, silica, petrolatum, aloe etc., (sic) all of which read on instant hydrophilic components, along with emollients and wax (hydrophobic) in the lotion formulation.

[T]he lotion formulations be applied to the entire body face or may be applied selectively to particular sections, so as to provide greater lubricity to such sections and can be applied in stripes.

Office Action dated June 20, 2004; page 3-4. The Office then concludes that "it would have been obvious for one of ordinary skill in the art at the time of the instant invention to apply the lotion

composition in a desired thickness or amounts with an expectation to exhibit minimum migration.”

1. Krzysik fails to teach or suggest each and every limitation of Claim 9. Claim 9 is an article with a beneficial composition that “comprises a first layer and a second layer and wherein (a) the first layer is disposed on the contacting surface; (b) the second layer is disposed on the first layer, and (c) the first layer makes up between about 5% and about 95% of the beneficial component.” None of the four points the Office provides in support of the conclusion obviousness teaches or suggests the limitations recited in Claim 9. None of the four points addresses Krzysik’s lack of layers, deposition of the layers, and relative composition of the layers. Furthermore, the Office’s conclusion does not even address Claim 9. The Office concludes that Krzysik teaches or suggests “minimum migration”; however, the claim limitation is directed to a structure that is not taught or suggested by Krzysik. As a result, the Office has failed in its *prima facie* case of obviousness.

2. The Office has failed to provide a motivation for asserting that Krzysik’s deposition pattern of stripes suggests the limitation of layers in Claim 9. The Office asserts that “adding the beneficial agents, hydrophobic or hydrophilic or both, in discrete patterns such as layers . . . would have been within the scope of a skilled artisan.” The Office’s assertion is factually unsupported and purely conclusory. Case law states “[t]hat which is within the capabilities of one skilled in the art is not synonymous with obviousness.” *Ex parte Levengood*, 28 USPQ2d (Pat. Bd. Pat. App. & Inter. 1993), citing *Ex parte Gerlach*, 212 USPQ 471 (Bd. Pat. App. & Inter. 1980). The Office has failed in its initial burden to factually support the *prima facie* case of obviousness.

3. Krzysik fails to teach or suggest each and every limitation of Claim 16. Claim 16 is directed to the method for top-biasing a composition on a porous substrate comprising the steps of “(a) applying a first layer of a relatively hydrophobic component on the porous substrate, (b) applying a second layer of a relatively hydrophobic component; and (c) allowing the first and second layers to simultaneously cool on the substrate without the formation of an emulsion.” The Office offers that the same four points and the same reasoning as presented with respect to Claim 9 are equally applicable to Claim 16. None of these points teach or suggest each and every step in Claim 16. Again the Office states that “adding the beneficial agents, hydrophobic or hydrophilic or both, in discrete patterns such as layers . . . would have been within the scope of a skilled artisan.” The Office’s assertion is factually unsupported and purely conclusory. Case law states “[t]hat which is within the capabilities of one skilled in the art is not synonymous with obviousness.” *Ex parte Levengood*, 28 USPQ2d (Pat. Bd. Pat. App. & Inter. 1993), citing *Ex*

parte Gerlach, 212 USPQ 471 (Bd. Pat. App. & Inter. 1980). The Office has failed in its initial burden to factually support the *prima facie* case of obviousness.

4. The Office fails to appreciate that Krzysik teaches away from the Office's suggested modification to yield the method of Claim 16. Krzysik clearly discloses "uniformly applying the melted formulation to the bodyfacing surface of the bodyside liner." *Krzysik*, page 19, lines 26-29. Appellant's claim recites, in part, a method of applying a first layer of a relatively hydrophilic component and applying a second layer of a relatively hydrophobic component. Krzysik clearly requires uniform application of the lotion formulation which is contrary to Appellant's claimed layering. When the claimed method involves doing what the cited reference tries to avoid, "[t]his is the very antithesis of obviousness." *In re Buehler*, 515 F.2d 1134, 1141 (CCPA 1975).

5. The Office fails to provide a motivation to modify the article of Krzysik to result in the layers recited in Appellant's Claim 9 and 16 While Krzysik may teach hydrophilic and hydrophobic ingredients for the lotion formulation, Appellant claims applying a first layer of a relatively hydrophilic component and applying a second layer of a relatively hydrophobic component. Krzysik does disclose that its lotion formulation may be applied as stripes; however, the Office continues to views stripes and layers as equivalents. There is no convincing line of reasoning for asserting that Krzysik's deposition pattern of stripes suggests Appellant's method for applying a first layer of a relatively hydrophilic component and applying a second layer of a relatively hydrophobic component. The Office offers no teaching or suggestion that the Krzysik lotion formulation involves application of multiple layers. The Office's obviousness rejection remains unsupported in fact or by a convincing line of reasoning.

With regard to dependent claims not specifically addressed above, Appellant submits that all independent claims have been traversed. As such, all dependent claims depending therefrom and containing all limitations are also nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)

SUMMARY

It is respectfully submitted that Claims 1-3 and 5-21 have not been properly rejected under 35 U.S.C. § 103. In light the analysis and discussion provided above, Appellants

respectfully request the Board of Patent Appeals and Interferences to reverse the rejections of Claims 1-3 and 5-21 and to remand the application with instructions that these claims be allowed over the cited documents.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY


Signature

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CLAIMS APPENDIX

1. (Rejected) An article of manufacture for use in contact with a target surface, comprising:
 - a. a liquid permeable porous substrate having a contacting surface and an opposing surface disposed oppositely thereto, wherein the substrate has a thickness of "Z" as measured from the contacting surface to the opposing surface; and
 - b. a beneficial component releasably disposed on at least a portion of the contacting surface;wherein the beneficial component comprises at least a first layer and a second layer, whereby the ratio of the quantity of the beneficial component present on or within the thickness between 0 and $Z/3$ of the substrate is at least about 2.2 times the quantity of the component within the thickness between $2Z/3$ and Z of the substrate until the time of the use of the article.
2. (Rejected) The article of Claim 1, wherein the beneficial component comprises members selected from the group consisting of cleaning components, waxing components, and polishing components and where the article is intended for use on an inanimate surface.
3. (Rejected) The article of Claim 1, wherein the beneficial component comprises members selected from the group consisting of skin conditioning components, hair conditioning components, cosmetic components, and where the article is intended for use on an animate surface.
4. (Cancelled)
5. (Rejected) The article of Claim 1, wherein the beneficial component which comprises at least a first layer and a second layer, wherein at least one layer is relatively hydrophilic and at least one layer is relatively hydrophobic.
6. (Rejected) The article of Claim 1, wherein the beneficial component comprises an additive selected from the group consisting of pH stabilizers, vitamins, petrolatum, zinc oxide, hexamidine diisethionate, chamomile, tocopherol acetate, aloe extract, lanolin, enzyme inhibitors, surfactants, colorants, anti-microbials, kaolin, and mixtures thereof.
7. (Rejected) The article of Claim 1, wherein the article is an absorbent article selected from the group consisting of training pants, feminine napkins, pantliners, incontinence garments, breast pads or intra labial devices.
8. (Rejected) The article of Claim 1, wherein the article is a product selected from the group consisting of buffs, bandages, mops, cloths, wipes, sponges, or other flexible dispensing means intended for use on inanimate objects.

9. (Rejected) An article comprising a contacting surface having a beneficial component disposed on at least a portion thereof wherein the beneficial composition comprises a first layer and a second layer and wherein:
 - a. the first layer is disposed on the contacting surface;
 - b. the second layer is disposed on the first layer; and
 - c. the first layer makes up between about 5% and about 95% of the beneficial component.
10. (Rejected) The article of Claim 9, wherein the article is an absorbent article selected from the group consisting of training pants, feminine napkins, pantliners, incontinence garments, hemorrhoid pads, breast pads or intra labial devices.
11. (Rejected) The article of Claim 9, wherein the first layer is relatively hydrophilic and is disposed on the body contacting surface and the second layer is relatively hydrophobic and is disposed on the first layer.
12. (Rejected) The article of Claim 11, wherein the article is the topsheet of an absorbent article, the absorbent article further comprising:
 - a. a liquid impermeable backsheet; and
 - b. an absorbent core positioned between the topsheet and the backsheet.
13. (Rejected) The article of Claim 9, further comprising a third layer disposed on at least a portion of the second layer.
14. (Rejected) The article of Claim 9, wherein the difference in solubility parameters between the first layer and the second layer is less than or equal to two.
15. (Rejected) The article of Claim 14 wherein;
 - a. the first layer comprises members selected from the group consisting of petrolatum, stearyl alcohol, and fumed silica; and
 - b. the second layer comprises members selected from the group consisting of petrolatum, stearyl alcohol, fumed silica, and zinc oxide.
16. (Rejected) A method for Top-Biasing a composition on a porous substrate, the method comprising the following steps:
 - a. applying a first layer of a relatively hydrophilic component on the porous substrate;
 - b. applying a second layer of a relatively hydrophobic component on the relatively hydrophilic component; and
 - c. allowing the first layer and second layer to simultaneously cool on the substrate without the formation of an emulsion.

17. (Rejected) The method of Claim 16, wherein the relatively hydrophilic component is selected from the group consisting of glycerin, glycols, diols, urea, sodium chloride, water, and mixtures thereof.
18. (Rejected) The method of Claim 16, wherein the relatively hydrophilic component comprises a mixture of glycerin and water and wherein the relatively hydrophobic component comprises a mixture selected from the group consisting of petrolatum, stearyl alcohol, aloe solution, zinc oxide, fumed silica, and mixtures thereof.
19. (Rejected) The method of Claim 16, wherein the relatively hydrophobic component is selected from the group consisting of petrolatum, stearyl alcohol, behenyl alcohol, mineral oil, silicone, lanolin, and mixtures thereof.
20. (Rejected) The method of Claim 16, wherein the hydrophilic component comprises a volatile intermediary.
21. (Rejected) The article of Claim 1, wherein the first layer comprises a volatile base lotion such that the first layer dissipates subsequent to application of the second layer.

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